

REMARKS

In the Advisory Action the Examiner maintained the final the rejection of Claims 38-50 under 35 U.S.C. §103(a) as being unpatentable over the combined disclosures of U.S. Patent No. 6,270,805 to Chen et al. (“Chen”) in view of U.S. Patent No. 5,133,974 to Paradissis et al. (“Paradissis”) and stated:

Chen remains usable under 103(a) despite applicant’s assertion to the contrary. 103(c) states that the subject must not [sic] be owned by the same person at the time of the invention. The assignment is recorded as of 5/31/02, however the filing date of the instant application is 2/8/02, meaning that at the time of the invention the subject matter was not commonly owned. As such the Chen patent remains usable as prior art.

In response to this rejection, Applicants respectfully request reconsideration and allowance based upon the following comments and the Declaration of G. Michael Bryner, attached hereto as Exhibit A.

Applicants acknowledge the Examiner’s concerns of the applicability of 35 U.S.C. § 103(c) based upon the date on which the assignment of the above-captioned application was executed. In an effort to overcome the Examiner’s concerns, Applicants are submitting a Declaration of G. Michael Bryner. Mr. Bryner is the Vice President, Intellectual Property and Patent Counsel for Watson Pharmaceuticals, Inc. Watson Pharmaceuticals, Inc. acquired all Andrx Corporation, Andrx Pharmaceuticals, Inc. and Andrx Pharmaceuticals, LLC assets on November 3, 2006. Mr. Bryner declares that based upon an investigation of the Andrx employment records conducted at his direction, the above-identified application was subject to an obligation of assignment to Andrx Pharmaceuticals on at least February 8, 2001, the date the

priority provisional applications were filed, and by February 8, 2002, the date the subject application was filed.

35 U.S.C. § 103 (c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person **or subject to an obligation of assignment to the same person.**

(emphasis added).

The inventors listed on the subject application were employed by Andrx Pharmaceuticals at the time the invention was conceived and reduced to practice. As employees of Andrx Pharmaceuticals, the inventors had an obligation to assign all rights to Andrx Pharmaceuticals, Inc. See Exhibit A, ¶¶ 10-13 of Bryner Declaration. Further support for this can be found in U.S. Provisional Applications Nos. 60/267,456 and, 60/267,457, filed February 8, 2001, which are in the lineage of the subject application. The information in these applications, including the actual working examples and figures, are virtually identical to the information in the subject application.

Chen cannot constitute prior art under 35 U.S.C. §102(b) because Chen was published on August 7, 2001; the present application was filed less than one year later on February 8, 2002 and claims priority to U.S. Provisional Application Serial Nos. 60/267,456 and 60/267,457, both filed on February 8, 2001. Therefore, Chen can only constitute prior under 35 U.S.C. §102(e), and thus may be removed as a §103 prior art reference as per §103(c). Applicants respectfully aver that Chen is not a proper prior art reference because both Chen and the present application share two inventors in common (*i.e.*, Chih-Ming Chen and Xiu Xiu Cheng). Additionally, both applications were subject to an assignment and an obligation to assign to Andrx Pharmaceuticals,

Inc. In this regard, Applicants respectfully direct the Examiner's attention to the assignment recorded on January 12, 1999 at reel/frame 009691/0282, which assigned the Chen patent from the inventors to Andrx Pharmaceuticals, Inc. Applicants also respectfully direct the Examiner's attention to the attached Declaration of G. Michael Bryner.

Applicants respectfully request entry of the present submission because it places the application in condition for allowance. Early and favorable consideration is therefore earnestly solicited and respectfully requested. If the Examiner does not believe the pending claims are in proper form for allowance, Applicants invite the Examiner to call the undersigned to discuss ways to further expedite prosecution of this application.

Respectfully submitted,

/matthew j. solow/

Matthew J. Solow
Reg. No. 56,878

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EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT OPERATION

In re Application of:)
)
Li et al.) Group Art Unit: 1618
)
Serial No.: 10/071,257) Examiner: Young, Micah Paul
)
Filed: February 8, 2002)

For: **CONTROLLED RELEASE ORAL DOSAGE FORM**

New York, NY 10036
October 23, 2009

Mail Stop AMENDMENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF G. MICHAEL BRYNER

Dear Sir:

I, G. Michael Bryner , declare as follows:

1. I am currently Vice President, Intellectual Property and Patent Counsel of Watson Pharmaceuticals, Inc.

2. Watson Pharmaceuticals, Inc. acquired Andrx Corporation, all related Andrx entities and assets including Andrx Pharmaceuticals, Inc. and Andrx Pharmaceuticals, LLC on November 3, 2006. All Andrx entities are wholly owned subsidiaries of Watson Pharmaceuticals, Inc. Included in the acquisition were all rights to the above-captioned application and U.S. Patent No. 6,270,805.

3. I have reviewed the Advisory Action that issued on September 24, 2009 in the above-captioned application. I have also reviewed the above-captioned application including the two provisional applications, Serial No. 60/267,457 and Serial No. 60/267,456, both filed on February 8, 2001 to which the above-captioned application claims priority.

4. U.S. Provisional Application Serial No. 60/267,457 was filed on February 8, 2001 and identified Boyong Li, Chih-Ming Chen and Avinash Nangia as inventors.

5. U.S. Provisional Application Serial No. 60/267,456 was filed on February 8, 2001 and identifies Boyong Li and Xiu Xiu Cheng as inventors.

6. The above-captioned application, Serial No. 10/071,257, identifies Boyong Li, Chih-Ming Chen, Xiu Xiu Cheng and Avinash Nangia as inventors.

7. U.S. Patent No. 6,270,805 identifies Chih-Ming Chen and Xiu Xiu Cheng as inventors.

8. Both the above-captioned application, Serial No. 10/071,257, and U.S. Patent No. 6,270,805 were originally assigned to Andrx Pharmaceuticals, Inc. , and subsequently assigned to Andrx Pharmaceuticals, LLC based upon a merger.

9. Chih-Ming Chen and Xiu Xiu Cheng identified as inventors on U.S. Patent No. 6,270,805 are the same individuals identified as inventors on the above-captioned application, Serial No. 10/071,257

10. I understand from the Advisory Action that the Examiner believes U.S. Patent No. 6,270,805 is prior art to the above-captioned application. This belief is based in part upon a presumption that U.S. Patent No. 6,270,805 and the above-captioned application, Serial No. 10/071,257, were not co-owned at the time of invention.

11. In response to the Examiner's comments, I requested a review of the employment records of Andrx Pharmaceuticals, Inc. and was informed of the following:

Boyong Li was employed by Andrx from March 3, 1997 to February 7, 2003;

Chih-Ming Chen was employed by Andrx from November 20, 1992 to September 21, 2001;

Xiu Xiu Cheng was employed by Andrx from May 30, 1995 to November 2, 2007; and

Avinash Nangia was employed by Andrx from March 22, 2000 until April

30, 2004.

12. I was also informed by the Director of Analytical R&D, that as employees of Andrx, the inventors listed on Serial No. 10/071,257 were obligated to assign all rights to Andrx.

13. Based upon the inquiries conducted at my direction and my review of the above-captioned application and related provisional applications, I have concluded that the invention described in the specification of the above-captioned application was owned by Andrx Pharmaceuticals and/or under an obligation to assign the invention to Andrx Pharmaceuticals, Inc. as of February 8, 2001, the date of the provisional applications were filed and as of February 8, 2002 the date the above-captioned application was filed.

14. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; further that these statements and like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the above-referenced application or any patent issuing thereon.

Dated: October 23, 2009

A handwritten signature in black ink, appearing to read "G. Michael Bryner", written over a horizontal line.

G. Michael Bryner
Vice President
Intellectual Property and Patent Counsel
Watson Pharmaceuticals, Inc.